

REMARKS

Status of the Claims

Claims 16 and 17 are pending. Each of these claims is independent.

Office Action

Claims 16 and 17 are rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. (Office Action at 2.) In addition, claims 16 and 17 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. (Office Action at 3.)

Rejection Under § 112, First Paragraph

Although the Office Action states that claim 17 is rejected for failing to comply with the enablement requirement of § 112, first paragraph (Office Action at 2), the Office Action also sets forth arguments that seem to allege a failure to comply with the written description requirement of § 112, first paragraph (Office Action at 3). Applicant will address both requirements below.

First, it is appropriate to note that, as discussed in MPEP § 2163(I), § 112, first paragraph, includes a written description requirement which is “separate and distinct from the enablement requirement. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1560, 19 USPQ2d 1111, 1114 (Fed. Cir. 1991).” The Federal Circuit recently affirmed this holding of *Vas-Cath*, in an *en banc* decision rendered March 22, 2010.

Since its inception, this court has consistently held that § 112, first paragraph, contains a written description requirement separate from enablement, and we have articulated a “fairly uniform standard,” which we now affirm. *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562-63 (Fed.

Cir. 1991). Specifically, the description must “clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.” Id. at 1563 (citing In re Gosteli, 872 F.2d 1008, 1012 (Fed. Cir. 1989)). In other words, the test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. Id. (quoting Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570, 1575 (Fed. Cir. 1985)); see also In re Kaslow, 707 F.2d 1366, 1375 (Fed. Cir. 1983).

Ariad v. Lilly, No. 2008-1248, slip op. at 23.

Enablement

The Office Action in the present case cites *Fiers v. Revel*, 984 F.2d 1164 (Fed. Cir. 1993), in support of the Office Action’s allegation that claim 17 is not enabled under § 112, first paragraph. The Office Action appears to assert that, even though claim 17 does not include the word “means,” the recitation of “a processor. . .” in Applicant’s claim 17 renders claim 17 in “single means claim format” because claim 17 is allegedly “drawn to any ‘processor,’ regardless of construct, that performs the function recited.” (See Office Action at 2-3.) In *In re Hyatt*, 708 F.2d 712 (Fed. Cir. 1983), which is cited in the Office Action at 2, the court held that a single means claim fails to comply with the enablement requirement of § 112, first paragraph, because §112, sixth paragraph, only provides that means-plus-function limitations are acceptable in claims for combinations. *Hyatt*, 708 F.2d at 714.

Without conceding the Examiner’s apparent argument that claim 17 was analogous to a “single means claim,” Applicant has, in the interest of advancing prosecution, amended claim 17 to clarify that the system includes not only a processor, but also a memory, and that the executable instructions are contained by the memory.

Support for these amendments can be found in the original specification in, for example, paragraph [0130]. Accordingly, Applicant respectfully submits that claim 17, as amended, is definitively drawn to a combination and, therefore, is not a “single means claim,” nor is it analogous to a “single means claim,” and thus, does not run afoul of § 112, sixth paragraph, or the enablement requirement of § 112, first paragraph, simply for reciting a single element.

Moreover, in *Hyatt* the court noted that the basis for rejecting “single means claims” under § 112, first paragraph, as not being enabled, is founded on what was formerly known as “undue breadth.” In the present case, claim 17, as amended, recites not only a processor, but also a memory containing particular instructions. Therefore, the overall scope of claim 17 is not overly broad, and is, in fact, enabled.

Written Description

The Office Action appears to set forth a separate argument, alleging that claim 17 fails to comply with the written description requirement of § 112, first paragraph, although a separate rejection is not specifically set forth. The Office Action appears to draw an analogy between Applicant’s claimed processor and the claimed DNA in *Fiers*. (See Office Action at 3.) In view of this purported analogy, the Office Action concludes that, for the same reasons the court in *Fiers* found that the specification failed to satisfy the written description requirement with regard to the claimed DNA, Applicant’s claimed processor purportedly fails to satisfy the written description requirement. *Id.* However, Applicant respectfully submits that *Fiers* is not on point with respect to the present case.

In *Fiers*, the claim at issue pertained to nothing more than DNA having a particular function. *Fiers*, 984 F.2d at 1166. The court held that the claim was not enabled because there was no indication that the proponent actually had possession of the purportedly inventive DNA because the specification did not include a description of any particular DNA which had the claimed function. *Id.* at 1171-72.

In contrast, in the present application, the processor recited in claim 17 executes instructions, which reflect attributes of the processor. Indeed, it has been held that “[a patentee] may begin at the point where his invention begins, and describe what he has made that is new and what it replaces of the old. That which is common and well known is as if it were written out in the patent and delineated in the drawings.” *Loom Co. v. Higgins*, 105 U.S. (Otto.) 580, 586 (1881).

As further explained in MPEP § 2163(II)(A)(3)(a),

[w]hat is conventional or well known to one of ordinary skill in the art need not be disclosed in detail. See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d at 1384, 231 USPQ at 94. >See also *Capon v. Eshhar*, 418 F.3d 1349, 1357, 76 USPQ2d 1078, 1085 (Fed. Cir. 2005) (“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge. As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.”).< If a skilled artisan would have understood the inventor to be in possession of the claimed invention at the time of filing, even if every nuance of the claims is not explicitly described in the specification, then the adequate description requirement is met. See, e.g., *Vas-Cath*, 935 F.2d at 1563, 19 USPQ2d at 1116; *Martin v. Johnson*, 454 F.2d 746, 751, 172 USPQ 391, 395 (CCPA 1972) (stating “the description need not be in *ipsis verbis* [i.e., “in the same words”] to be sufficient”).

Also, as discussed in MPEP § 2163(II)(A),

[t]he examiner has the initial burden, after a thorough reading and evaluation of the content of the application, of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims.

Further,

The absence of definitions or details for well-established terms or procedures should not be the basis of a rejection under 35 U.S.C. 112, para. 1, for lack of adequate written description.

MPEP § 2163(II)(A)(1),(emphasis added).

Here, Applicant provides, e.g., in paragraph [0131] of the specification, a description of an exemplary "processor," explaining that, among other things, the term processor can include a "data processor." As noted in MPEP § 2163(II)(A)(3)(a),

In re Hayes Microcomputer Products, Inc. Patent Litigation, 982 F.2d 1527, 1534-35, 25 USPQ2d 1241, 1246 (Fed. Cir. 1992) ("One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention. An applicant's disclosure obligation varies according to the art to which the invention pertains. **Disclosing a microprocessor capable of performing certain functions is sufficient to satisfy the requirement of section 112, first paragraph, when one skilled in the relevant art would understand what is intended and know how to carry it out.**").

(Emphasis added.) Applicant respectfully submits that the features of a processor for executing instructions contained by a memory are within the knowledge of a skilled artisan and, therefore, need not be described at length in the specification.

For at least the foregoing reasons, Applicant respectfully submits that the rejection of claim 17 under § 112, first paragraph should be withdrawn.

Rejection Under § 112, Second Paragraph

Applicant respectfully submits that the rejection of claims 16 and 17 under § 112, second paragraph, should be withdrawn. The essential inquiry pertaining to 35 U.S.C. § 112, second paragraph, is “whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity.” MPEP § 2173.02.

The Office Action alleges that, based on definitions of the terms “facilitating” and “enabling” in the specification,

the method step of: “facilitating display” does not require the actual act of “displaying” to be performed, and the method step of “enabling selection of at least one of the displayed templates” does not require the actual selection step to be performed, which is confusing. So as neither “displaying” nor “selecting” steps are required by the claim, it is not clear which method steps have to be performed to achieve actual “displaying” and “selecting” results.

(Office Action at 4.)

Although Applicant respectfully disagrees with this rejection, Applicant has, in the interest of advancing prosecution, amended claims 16 and 17 to remove the terms “facilitating,” “enabling,” and “facilitating” and to, instead, recite “displaying,” “selecting,” and “displaying,” respectively. Accordingly, Applicant respectfully submits that the rejection of claims 16 and 17 under § 112, second paragraph, should be withdrawn.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that each of independent claims 16 and 17 is allowable.

Applicant respectfully requests reconsideration of this application and the timely allowance of pending claims.


The Office Action contains a number of statements reflecting assertions and/or allegations concerning the claims. Regardless of whether any such statement is identified above, Applicant declines to subscribe to any assertion or allegation in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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